## REMARKS

The Specification has been amended. Claims 1 - 8, 11 - 18, and 21 - 28 have been amended. No new matter has been introduced with these amendments, all of which are supported in the specification as originally filed. Claims 1 - 30 remain in the application.

I. Rejection under 35 U.S.C. §102(b)

Paragraph 2 of the Office Action dated July 11, 2006 (hereinafter, "the Office Action") states that Claims 1 - 5 and 11 - 15 are rejected under 35 U.S.C. §102(b) as being anticipated by Ogasawara (U.S. Patent 6,327,576) or alternatively, under 35 U.S.C. §103(a) as being unpatentable over Ogasawara in view of Chung (U.S. Patent 6,961,000). Paragraph 5 of the Office Action states that Claims 21 - 25 are rejected using similar rationale.

Applicants have amended their independent Claims 1, 11, and 21 to more clearly specify limitations of their claimed invention, and the rejection is respectfully traversed with regard to the claims as amended.

In contrast to Applicants' claimed invention (Claim 1, lines 1 - 2 and lines 11 - 15), it is clear that Ogasawara is not concerned with theft detection or prevention. Ogasawara is directed to techniques for passing information about the expiration dates of perishable purchased products from the seller to the purchaser in an electronic form (i.e., an electronic receipt) in a way that enables the purchaser to subsequently manage the shelf-life of perishable and opened products. See, for example, the Title and the Abstract (for example, lines 1 - 4 thereof). See also col. 2, line

66 - col. 3, line 4, stating "... expiration dating information pertaining to large classes of perishable goods, such as grocery items, is acquired ... and maintained ... to make this information [i.e., the expiration dating information] available to a consumer in the form of an electronic receipt".

Ogasawara gets product-identifying information from the product being purchased in several ways, to include scanning a bar code on the product (col. 3, lines 28 and 34) or reading an RFID tag on the product (col. 5, lines 2 - 5 and lines 10 - 11). When using a bar code scanner, Ogasawara states that the scanning is done ""[i]n conventional fashion" (col. 3, lines 34 - 35) to obtain an item's UPC or SKU from a label attached to the item (col. 3, lines 35 - 38). In contrast to Applicants' claimed invention where the information to be stored is obtained by reading an RFID tag affixed to an item (Claim 1, lines 3 - 5), Ogasawara states (col. 3, lines 47 - 59; col. 5, lines 38 - 44) that the information he puts on the electronic receipt (termed "the requisite information") is obtained by looking up the product-identifying information in a database. Applicants note that Ogasawara does describe an enhancement whereby the expiration dating information might be stored in an RFID tag; however, as discussed in more detail below and as contrasted to Applicants' claimed invention, this is not item-unique information that is capable of individually identifying an item.

In contrast to Applicants' claimed invention where machine-readable item-unique identifying information is stored on a printed sales receipt (Claim 1, lines 6 - 11), Ogasawara explicitly indicates that his electronic receipt is something separate and distinct from a conventional printed paper receipt. See col. 3, lines 59 - 64 (emphasis added), stating "It should

be noted that the electronic receipt **18** is generated in addition to a conventional paper receipt [i.e., there are 2 receipts] ... [or] The electronic receipt **18** might be the primary and only receipt generated [i.e., there is only 1 receipt, and it is an electronic receipt] ... i.e., the paper receipt might be provided optionally or not at all ...". If it is optional that the paper receipt is provided, it is clear that the electronic receipt is not *on* the paper receipt. Thus, they are clearly separate things.

See also col. 3, line 65 - col. 4, line 5 (emphasis added), stating that "... alternatively [i.e., instead of giving the electronic receipt to the customer], the electronic receipt **18** might be electronically transferred to a web server **20** belonging to the retail facility ... for eventual retrieval by the consumer". The consumer/customer might log on to a store's web server via the Internet, for example, to retrieve that customer's electronic receipt after he/she arrives at home from shopping (col. 4, lines 30 - 39). Accordingly, it is clear that the electronic receipt is not being affixed to a conventional paper receipt in Ogasawara, and that it is something capable of taking a completely separate path from a paper receipt (that is, sending the electronic receipt to the customer over the Internet, whereas a paper receipt would be given in person to the customer).

Ogasawara discusses another alternative for delivery of his electronic receipt, namely to store the electronic receipt into a "purpose-designed IC card [having] sufficient memory storage space into which an electronic receipt might be written" (col. 4, lines 6 - 10). As an example of such IC card, an "RF-type card" may be used (col. 4, line 15). Ogasawara states that writing the electronic receipt to an IC card "offers the customer a simple and efficient method of receiving an

electronic receipt ... and for transporting the electronic receipt to a remote location, such as the home ..." (col. 4, lines 20 - 25). However, it is clear that Ogasawara does not also write the paper receipt to this IC card (as this would seem to be physically impossible), and this again demonstrates that Ogasawara is using an electronic receipt that is separate from a paper receipt.

See also col. 5, lines 46 - 67, again stating that the electronic receipt can be transmitted to a web server **20**, and clarifying that it does not have to be generated by the point-of-sale terminal **10** before transferring it to the web server (col. 5, lines 54 - 56, "need not necessarily be generated ... before transmission to the store's web server **20**"). In other words, the electronic receipt can be generated at the back-end system **20**, without regard to where the actual customer (who would receive the paper receipt) happens to be. This is clearly distinct from Applicants' claimed invention, where the machine-readable form of information is stored on the printed sales receipt (Claim 1, lines 6 - 11).

Applicants note the text in col. 8, lines 38 - 42, stating "... an electronic receipt is generated, often in conjunction with an optional conventional paper receipt", which has been cited by the Examiner on p. 2 of the Office Action. However, Applicants respectfully submit that it is clear that "in conjunction with" does not suggest that the two forms of receipt are provided on the same physical entity (that is, the electronic receipt is not provided on the conventional paper receipt, in contrast to Applicants' storing of machine-readable information on a printed sales receipt). Otherwise, the words "often" and "optional" would have no place in the sentence, and in fact would make the sentence incorrect. In addition, the references to Ogasawara's text which

have been cited above with regard to Applicants' Claim 1, lines 6 - 11 make clear that the electronic receipt and conventional paper receipt are physically separate things.

In contrast to Applicants' claimed invention where the RFID tag stores item-unique identifying information that can individually identify the item to which the tag is affixed (Claim 1, lines 3 - 5), Ogasawara refers to item RFID tags storing PLU, SKU, or UPC information (col. 5, line 31). It is well known that none of these types of identifiers are capable of individually identifying an item, in contrast to the item-unique identifiers used by Applicants (Claim 1, lines 3 - 5 and lines 13 - 15). A PLU, for example, is a four-to-five digit number indicating a type of produce (e.g., fruit or vegetable), and optionally information such as a variety thereof and whether the produce was organically grown (see http://en.wikipedia.org/wiki/Price_Look-Up). Applicants have explained in their specification that an SKU, standing alone, cannot individually identify an item (Specification, p. 10, lines 6 - 7), and it is well known that a UPC also identifies items by type and cannot individually identify an item. Ogasawara has no discussion, nor any suggestion, of information readable from an RFID tag that can individually identify an item. Rather, Ogasawara states a technique for counting the number of items of a particular type (see col. 7, lines 11 - 14, emphasis added "As new items are received in inventory, each item's bar code or RFID label is scanned or read and the inventory field [from a table in which expiration dating information is being maintained] associated with that particular code is incremented.") and states an alternative approach whereby the expiration dating information might be added to an item's RFID tag (col. 7, lines 54 - 64). However, Ogasawara states that an RFID tag includes "lot number" for an item, and then explains how these lot numbers (which do not individually identify

an item) could be used for tracking product expiration (col. 7, lines 16 - 23), and it is therefore clear that Ogasawara does not teach using RFID tags that individually identify items.

In addition, Applicants find no teaching, nor any suggestion, in Ogasawara that any of the information he puts on his electronic receipt is in any way capable of individually identifying the items. Rather, as discussed above (and as illustrated in **Fig. 4**, which provides a sample electronic receipt layout, as stated in col. 2, lines 52 - 53), the information Ogasawara puts on his electronic receipt is an item type (derived from its SKU, PLU, or UPC), such as "Fuji Apples" or "2-ply tissue" (see **Fig. 4**, first and fifth items on the electronic receipt). This does not provide the ability to "detect[ ] whether a collection of one or more items is identical to the one or more items purchased", in contrast to Applicants' claimed invention (Claim 1, lines 11 - 15), and it is clear that Ogasawara has not described or suggested this type of "detecting".

Accordingly, it can be seen that Ogasawara does not anticipate Applicants' independent Claim 1. Independent Claims 11 and 21 specify analogous limitations, and the above-provided analysis applies equally thereto.

With regard to Chung, Applicants respectfully submit that a *prima facie* case of obviousness under 35 U.S.C. §103 has not been made out. Section 706.02(j) of the MPEP, "Contents of a 35 U.S.C. 103 Rejection", states the requirements for establishing a *prima facie* case of obviousness under this statute, noting that three criteria must be met. These criteria are (1) a suggestion or motivation, found either in the references or in the knowledge generally

available, to modify or combine the references; (2) a reasonable expectation of success; and (3) the combination must teach all the claim limitations. This text goes on to state that "The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.". The three requirements for establishing a *prima facie* case of obviousness are also stated in MPEP §2142, "Legal Concept of *Prima Facie* Obviousness", and MPEP §2143, "Basic Requirements of a *Prima Facie* Case of Obviousness".

The Office Action provides no motivation for combining Ogasawara and Chung. As stated above, this is a requirement for establishing a *prima facie* case of obviousness. Therefore, a proper §103 rejection has not been made out, and without more, Claims 1 - 5, 11 - 15, and 21 - 25 are deemed patentable. See ***In re Oetiker***, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992), which stated:

> If the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.

In view of the above, the Examiner is respectfully requested to withdraw the §102 rejection and alternatively, the §103 rejection, of Claims 1 - 5, 11 - 15, and 21 - 25.

II. Rejection under 35 U.S.C. §103(a)

Paragraph 4 of the Office Action states that Claims 6 - 10 and 16 - 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shanahan et al. (U.S. Patent Publication 2004/0148226; hereinafter, "Shanahan") in view of Ogasawara. Paragraph 6 of the Office Action states that Claims 26 - 30 are rejected using similar rationale.

Applicants have amended their independent Claims 6, 16, and 26 to more clearly specify limitations of their claimed invention, and the rejection is respectfully traversed with regard to the claims as amended.

Paragraph 4 of the Office Action dated February 23, 2006 (hereinafter, "the prior Office Action") admits that Shanahan "omits disclose [sic] the e-receipt in details". Ogasawara is then cited therein for this teaching; similarly, a combination of Shanahan and Ogasawara is cited in the present Office Action.

In response, as Applicants have explained above, a number of differences can be found between their claimed invention and the electronic receipt discussed in Ogasawara. As one example, Ogasawara does not pertain to theft detection, in contrast to Applicants' claimed invention (Claim 6, line 1 and lines 13 - 15). As another example, it is clear that Ogasawara describes use of two separate receipts, one being an electronic receipt and another being a conventional paper receipt (or, alternatively, completely omitting the paper receipt), and states that the electronic receipt can be transmitted (for example) over the Internet, which is distinct from Applicants' claimed invention where machine-readable information is stored on the printed sales receipt (Claim 6, lines 3 - 9). As yet another example, Ogasawara does not individually identify items on his electronic receipt, in contrast to Applicants' claimed invention where item-unique identifying information is stored and where this item-unique identifying information individually identifies the item (Claim 6, lines 3 - 9).

Applicants find no teaching in Shanahan of "... a printed sales receipt with item-unique identifying information stored thereon, in a machine-readable form ..." (Claim 6, lines 3 - 4, emphasis added), and the prior Office Action admits that Shanahan does not provide detailed information on electronic receipts.

Accordingly, Applicants respectfully submit that a combination of Shanahan and Ogasawara does not, in fact, render their claimed invention obvious, as neither reference nor a combination thereof teaches all limitations of independent Claims 6, 16, and 26. The above-stated third element of the *prima facie* case of obviousness is therefore missing.

Furthermore, Applicants respectfully submit that the supposed motivation provided in the Office Action for combining the references is improper. Page 4 of the Office Action states, as motivation for combining Shanahan and Ogasawara, that "it would have been obvious ... to replace the consumer carried electronic sales receipt of **Shanahan** with an IC tag affixed to a printed sales receipt of **Ogasawara** ..." (Office Action, p. 4, lines 7 - 9, emphasis original). Applicants respectfully submit that this supposed motivation is improper, as Ogasawara does not disclose "an IC tag affixed to a printed sales receipt"; this has been discussed above, where Applicants have provided a number of citations to text in Ogasawara specifying that the electronic receipt is separate and distinct from a printed sales receipt.

Page 4 of the Office Action further states, as motivation for combining Shanahan and Ogasawara, that "... information can be securely stored and reproduced ..." (Office Action, p. 4,

lines 10 - 11). Applicants respectfully submit that this supposed motivation is improper, as their claimed invention does not specify "reproducing" information.

Accordingly, the above-stated first element of the *prima facie* case of obviousness is therefore missing. Because (at least) the first and third elements of the *prima facie* case are missing, as has been demonstrated herein, Applicants respectfully submit that Claims 6, 16, and 26 are not rendered obvious by a combination of Shanahan and Ogasawara. Their dependent Claims 7 - 10, 17 - 20, and 27 - 30 are therefore deemed patentable by virtue of (at least) the patentability of the independent claims from which they depend.

III. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and passage of the application to issuance at an early date.

Respectfully submitted,

/Marcia L. Doubet/ /#40,999/

Marcia L. Doubet,
Attorney for Applicants
Reg. No. 40,999

Customer Number for Correspondence: 43168
Phone: 407-343-7586; Fax: 407-343-7587